

REMARKS

Reconsideration of the application in view of the above amendments and following remarks is requested. Claims 1-21 and 24-45 are in the case. Claims 1-5, 12, 13, 15, 17, 19, 21, 24, 25, 30 and 39 were amended. The present amendments add no new matter. These amendments present the case for allowance under 37 CFR §1.116(a).

A. Rejections Addressed from October 3, 2007 Office Action (OA)**(1) Rejection of claims 1-21 and 24-45 under 35 U.S.C. §112. Paragraph 1 (Enablement)**

The Office maintains the rejection of claims 1-21 and 24-45 under 35 U.S.C. §112, first paragraph because the specification while enabling for polynucleotide sequence of SEQ ID NO:1 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 1 to nucleotide 1682 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 1 to nucleotide 779 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 1 to nucleotide 833 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 1 to nucleotide 2887 or polynucleotide sequence of SEQ ID NO:834 [1 not 834] from nucleotide 1 to nucleotide 2887 polynucleotide sequence of SEQ ID NO:1 from nucleotide 126 to nucleotide 779 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 126 to nucleotide 833 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 834 to nucleotide 1682 or polynucleotide sequence of SEQ ID NO:1 from nucleotide 126 to nucleotide 1682 or nucleotide sequence encoding SEQ ID NO:2 from amino acid 20 to amino acid 237 or nucleotide sequence encoding SEQ ID NO:2 from amino acid 20 to amino acid 255 or nucleotide sequence encoding SEQ ID NO:2 from amino acid 256 to amino acid 538 or nucleotide sequence encoding SEQ ID NO:2 from amino acid 20 to amino acid 538 or polynucleotide sequences complementary, does not reasonably provide enablement for all possible nucleotide fragments contemplated by the Applicant (OA, page 2-3). The Office further asserts that the claims also recite the phrases "a polynucleotide sequence" and "a polypeptide" and thus, are broadly interpreted by the Office as reading upon: (i) fragments of SEQ ID NOs:1-2, including sequences only 10 amino acids or 60 nucleic acids in length. Applicants respectfully traverse this rejection. The instant claims render the rejection moot.

Applicants disagree with the Office's interpretation phrases such as "a polynucleotide sequence" and "a polypeptide," which are isolated from the language of the claim as a sentence or the claim when read as a whole, and are hence taken out of the claim's context. Applicants have presented amendments to the claims which remove such language, hence making the rejection moot. The instant claims are drawn to defined

polynucleotide fragments and embodiments of the polynucleotides of the present invention that are clearly enabled, as admitted by the Office. Consequently, rejection of claims 1-21 and 24-45 under 35 U.S.C. §112, first paragraph (Enablement), should be properly withdrawn.

(2) Rejection of claims 1-21 and 24-45 under 35 U.S.C. §112. Paragraph 1 (Written Description)

The Office maintains the rejection of claims 1-21 and 24-45 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office presents the same argument for this rejection as it did for the Enablement rejection (Part A.(1) above). Applicants respectfully traverse this rejection. The instant claims render the rejection moot.

As discussed above, Applicants disagree with the Office's interpretation phrases such as "a polynucleotide sequence" and "a polypeptide," which are isolated from the language of the claim as a sentence or the claim when read as a whole, and are hence taken out of the claim's context. Applicants have presented amendments to the claims which remove such language, hence making the rejection moot. The instant claims are drawn to defined polynucleotide fragments and embodiments of the polynucleotides of the present invention that are clearly described in a manner demonstrating possession of the invention, as admitted by the Office. Consequently, rejection of claims 1-21 and 24-45 under 35 U.S.C. §112, first paragraph (Written Description), should be properly withdrawn.

(3) Rejection of claims 1-21 and 24-45 under 35 U.S.C. §102 35 U.S.C. §112(e) (Anticipation)

The Office maintains the rejection of claims 1-21 and 24-45 under 35 U.S.C. §102(e) as allegedly being anticipated by Donaldson et al. (U.S. Patent No. 6,057,128). Applicant respectfully traverses this rejection.

Under 35 U.S.C. §102(e), for a prior art reference to anticipate a claim, every element of the claim must be included in a single reference. The instant claims are drawn to polynucleotides that encode polypeptides of SEQ ID NO:2, that consist of defined fragments: (a) fragments consisting of amino acid 20-237 of SEQ ID NO:2, (b) fragments consisting of amino acid 20-255 of SEQ ID NO:2, (c) fragments consisting of

Applicants: Scott R. Presnell et al.

Serial No.: 10/715,998

Filed: November 18, 2003

For: POLYNUCLEOTIDES ENCODING CYTOKINE RECEPTOR ZALPHA11

amino acid 238-255 of SEQ ID NO:2, (d) fragments consisting of amino acid 238-538 of SEQ ID NO:2, (e) fragments consisting of amino acid 256-538 of SEQ ID NO:2 and (f) fragments consisting of amino acid 20-538 of SEQ ID NO:2, and polynucleotides complementary to the sequences above. Moreover, the instant claims are drawn to polynucleotides that consist of defined fragments: (a) fragments consisting of amino acid 126-779 of SEQ ID NO:1, (b) fragments consisting of amino acid 126-833 of SEQ ID NO:1, (c) fragments consisting of amino acid 834-1682 of SEQ ID NO:1 and (d) fragments consisting of amino acid 126-1682 of SEQ ID NO:1, and polynucleotides complementary to the sequences above. These defined fragments are not described in the Donaldson et al. reference. Thus, the instant claims are not anticipated by Donaldson, because not all elements within the claims are disclosed in the reference.

As discussed above, Applicants disagree with the Office's interpretation phrases such as "a polynucleotide sequence" and "a polypeptide," which are isolated from the language of the claim as a sentence or the claim when read as a whole, and are hence taken out of the claim's context. Applicants have presented amendments to the claims which remove such language, hence making the rejection moot. The instant claims are drawn to defined polynucleotide fragments and embodiments of the polynucleotides of the present invention that are clearly defined, and are not present in Donaldson et al.

Since this single Donaldson et al., reference does not teach every element of the claimed invention, it cannot anticipate the invention. Consequently, Applicants respectfully request that rejections of instant claims 1-21 and 24-45, under 35 U.S.C. §102(e) be properly withdrawn.

(4) Rejection of claims 1-21 and 25-45 under nonstatutory obviousness-type double patenting

The Office maintains the provisional rejection of claims 1-21 and 25-45 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-36 of copending Application No. 11/537,874.

The Office also maintains the provisional rejection of claims 1-21 and 25-45 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/537,879.

Applicants: Scott R. Presnell et al.

Serial No.: 10/715,998

Filed: November 18, 2003

For: POLYNUCLEOTIDES ENCODING CYTOKINE RECEPTOR ZALPHA11

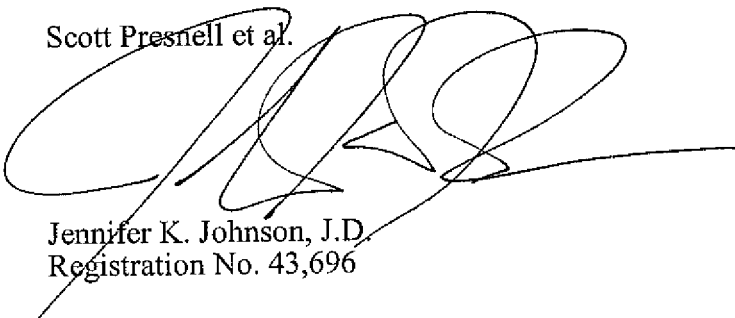
Upon an indication of otherwise allowable subject matter and in the event that these rejections are maintained for the pending Claims, Applicants will provide a response and Terminal Disclaimer if appropriate.

Early reconsideration and allowance of the pending claims is respectfully requested. If for any reason the Examiner feels that a telephone conference would expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (206) 442-6676.

It is believed that no fee is due. However, in the event that a fee is due, please charge any fee or credit any overpayment to Deposit Account No. 26-0290.

Respectfully Submitted,

Scott Presnell et al.


Jennifer K. Johnson, J.D.
Registration No. 43,696

Enclosure:

Notice of Appeal

Customer No. 10117

ZymoGenetics, Inc.

1201 Eastlake Avenue East

Seattle, Washington 98102